

RECEIVED

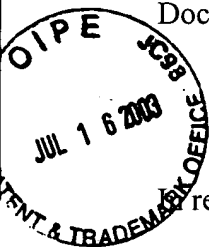
JUL 18 2003

TC 1700

AF

Docket No.: 44084-498

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

7/28/03
#16 Reply
Brief

Re Application of

Kimiyuki ITO, et al.

Serial No.: 09/955,030

Group Art Unit: 1756

Filed: September 19, 2001

Examiner: RODEE, Christopher D.

For: PHOTSENSITIVE MEMBER

TRANSMITTAL OF REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450


Sir:

Submitted herewith in triplicate is Appellants' Reply Brief to Examiner's Answer. Please charge any associated fees to Deposit Account 500417.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:khh/cac
Facsimile: (202) 756-8087
Date: July 17, 2003

Docket No.: 44084-498



RECEIVED
JUL 18 2003
TC 1700

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Kimiyuki ITO, et al.

Serial No.: 09/955,030

Filed: September 19, 2001

For: PHOTSENSITIVE MEMBER

:
:
:
:
:
:
:

Group Art Unit: 1756

Examiner: RODEE, Christopher D.

REPLY BRIEF

Commissioner for Patents
Washington, DC 20231

Sir:

This Reply Brief is submitted in response to the Examiner's Answer dated March 28, 2003.

ARGUMENTS

Appellants solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103 for the reasons set forth in the Appeal Brief submitted March 3, 2003 and for the reasons set forth herein.

Opening Statement

Appellants will show that the Examiner has adopted a legally erroneous approach to the ultimate legal conclusion of obviousness under 35 U.S.C. § 103.

The Objective of Rokutanzono [et al.]

The objective of Rokutanzono [et al.] is to provide an electrophotographic photoconductor that contains a protective layer having high transparency. However, when the average size of antimony doped tin oxide particles is larger than 0.3 micrometers, the object cannot be sustained. Thus, Rokutanzono discloses using antimony doped tin oxide having a size of 0.3 microns or less.

The Objective of Bergmann [et al.]

Bergmann [et al.] disclose transparent coatings prepared from tantalum doped tin oxide and the size of the electroconductive powders or particles range in size from about 0.05 to about 15 micrometers (column 4, lines 5-7). However, Bergmann [et al.] do not disclose or suggest that tantalum doped tin oxide is used in a surface protective layer for an electrophotographic photoconductor. In this regard, the objective of Bergmann [et al.] is to provide electroconductive coatings to be employed to prevent build-up of electrostatic charges when manufacturing electronic components or parts, such as computer chips, because these parts need to be protected from electrostatic discharge. Thus, Bergmann [et al.] envision the use of the electroconductive coatings for floors, walls and furniture in "clean rooms" where electronic parts are produced (see column 1, line 63 to column 2, line 7). Bergmann [et al.] also contemplate the powders of the invention to be employed in coatings for recyclable containers and other materials, e.g., packaging. Thin films or coatings containing electroconductive powders can also be used within polymer films or fibers, magnetic recording tapes, on work surfaces and in paints to impart electroconductive properties (see column 2, lines 18-24).

Bergmann [et al.] do not disclose or suggest anything about a protective layer for preventing damage to a photosensitive layer and to improve durability. In particular, Bergmann [et al.] disclose

nothing about problems in such a protective layer when the mean particle size (of the protective layer) is too large or too small as described at page 34, lines 5-9; i.e., "When the particle size is too large, cleaning characteristics are reduced due to toner abrasion. When particle size is too small, it becomes difficult to achieve uniform dispersion of the particles within the layer, leading to inadequate cleaning (of the protective layer of photosensitive member)".

While Rokutanzono [et al.] disclose a protective layer for an electrophotographic photoconductor and having antimony doped tin oxide having a size of 0.3 microns or less, it is only through improper hindsight reconstruction of the claimed invention that the Examiner maintains that a person of ordinary skill in the art would substitute or modify the protective layer of Rokutanzono [et al.] (having antimony doped tin oxide having a size of 0.3 microns or less) with the transparent coatings of Bergmann [et al.], prepared from tantalum doped tin oxide having a size from about 0.05 to about 15 micrometers, as there is no disclosure or suggestion in Bergmann [et al.] of using such Otantalum doped tin oxide in a protective layer for an electrophotographic photoconductor.

There is no Motivation

Clearly, the useful size of tantalum doped tin oxide powder in a surface protective layer for an electrophotographic photoconductor, as recited in the claims (0.3 to 1.0 micrometers), is disclosed only in Appellants' present application. Thus, the only apparent motivation of record for the modification of Rokutanzono [et al.] proposed by the Examiner to arrive at the claimed inventions is found in Appellants' disclosure which, of course, may not properly be relied upon to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 227 1 USPQ2d 1593 (Fed. Cir. 1987). It is, therefore, respectfully submitted that the Examiner has not established the requisite motivation for the proposed combination of references to arrive at the claimed

invention.

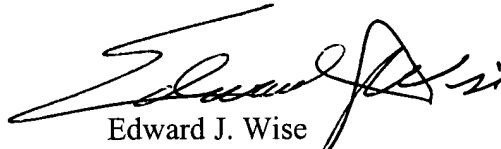
Conclusion

Appellants, therefore, submit that the Examiner's rejections under 35 U.S.C. § 103 are not factually or legally viable. Appellants, therefore, respectfully solicit the Honorable Board to reverse each of the Examiner's rejections under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Edward J. Wise
Registration No. 34,523

600 13th Street, N.W.
Washington, DC 20005-3096
(202) 756-8000 EJW:khb/cac
Facsimile: (202) 756-8087
Date: July 16, 2003